

2/27/01

**THIS DISPOSITION
IS NOT CITABLE AS PRECEDENT
OF THE T.T.A.B.**

Paper No. 16
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Portofino Sun Center Corp.

v.

Brigata International, Inc.

Opposition No. 111,788
to application Serial No. 75/318,322
filed on July 2, 1997

Jay A. Bondell of Schweitzer Cornman Gross & Bondell LLP for
Portofino Sun Center Corp.

Joseph L. Strabala for Brigata International, Inc.

Before Cissel, Quinn and Holtzman, Administrative Trademark
Judges.

Opinion by Cissel, Administrative Trademark Judge:

On July 2, 1997, applicant filed the above-referenced application to register the mark "PORTOFINO" on the Principal Register for "clothing; namely, men's shirts, jackets, suits, pants, blazers, shorts, t-shirts, under garments, sleepwear, shoes, and socks," in Class 25. The basis for filing the application was applicant's assertion that it possessed a bona fide intention to use the mark in commerce in connection with these goods.

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Following publication of the mark in accordance with Section 12(a) of the Lanham Act, a timely Notice of Opposition was filed by Portofino Sun Center Corp. on August 31, 1998. As grounds for opposition, opposer asserted that since long prior to the filing date of the opposed application, opposer has been engaged in the business of providing artificial sun tanning services and related goods and services; that opposer owns United States Registration No. 1,527,489 for the mark "PORTOFINO SUN CENTER" and design for artificial sun tanning services; that in connection with providing these services, since prior to the filing date of the opposed application, opposer has offered for sale, sold and distributed sportswear clothing items, including t-shirts, bearing the mark "PORTOFINO"; and that applicant's mark so resembles opposer's mark that if applicant were to use it in connection with the goods specified in the application, confusion would be likely.

Applicant's answer to the Notice of Opposition denied the essential allegations therein.

A trial was conducted in accordance with the Trademark Rules of Practice. Opposer took the testimony of its senior vice president, Vittorio Assaf. Applicant did not provide any testimony or exhibits. Opposer filed a brief with the Board, but applicant did not. An oral hearing before the Board was not requested.

The issues before the Board in this proceeding are priority and likelihood of confusion. The record clearly establishes opposer's priority and that confusion would be likely if applicant were to use its mark in connection with the goods set forth in the application.

In order to meet its burden of establishing priority with respect to clothing in this proceeding, all opposer had to do was to establish proprietary rights in "PORTOFINO" before the filing date of the opposed application, July 2, 1997. *Miller Brewing Co. v. Anheuser-Bush, Inc.* 27 USPQ2d 1711 (TTAB 1983). The uncontroverted testimony of Mr. Assaf establishes that opposer has used "PORTOFINO" in connection with both tanning salon services and items of apparel, including t-shirts, since the mid-1980s.

We thus turn to the issue of whether confusion would be likely if applicant were to use the mark it seeks to register in connection with the goods set forth in the application. In the case of *In re E. I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), the predecessor of our primary reviewing court identified the principal factors to be considered in determining whether confusion is likely. Chief among these factors are the similarities between the marks and the relationship between the goods.

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In the instant case, opposer has used "PORTOFINO" by itself and as the dominant component of several other marks. The record shows that opposer has used "PORTOFINO," "PORTOFINO SUN CENTER" and "PORTOFINO CASUAL" in connection with its goods and services. Opposer's pleaded registered¹ mark is shown below.

The mark applicant seeks to register is identical to one of opposer's marks and is the dominant component of the others, so our inquiry must turn to the relatedness of the goods and services of applicant and opposer in order to determine if confusion would be likely.

Opposer has used its marks, as noted above, in connection with its tanning salon services as well as with items of apparel which have been both sold outright and given away as promotional items in connection with the tanning salon services. The record establishes that opposer has used the same mark applicant seeks to register on the same goods that are identified in the application, namely,

¹ Reg. No. 1,527,489, issued on the Principal Register on Feb. 28, 1989; use since September, 1985 is claimed; "CENTER" is

t-shirts, as well as on hats, sweat pants and jackets. As of the time Mr. Assaf's testimony was taken, opposer had been using "PORTOFINO" on clothing items and in connection with its services for about fifteen years.

Just as the goods identified in the application would be sold to ordinary consumers through the usual channels of trade for such products, opposer's goods and services are also provided to ordinary consumers at the retail level. The fact that opposer offers a variety of goods, including apparel, at its tanning salon locations shows that consumers have a basis upon which to expect such products to be sold in this way.

The marks of the parties are the same and/or substantially similar and the goods are in part identical and otherwise closely related. Plainly, if applicant's t-shirts bearing the mark "PORTOFINO" were to be sold at any of the places where t-shirts are normally available, consumers familiar with opposer's use of the same mark on t-shirts and in connection with tanning salon services would be likely to assume, mistakenly, as it would turn out, that applicant's shirts and opposer's shirts emanate from the same source, or that the makers or sellers of them are in some way affiliated with each other.

disclaimed; affidavits under Sections 8 and 15 received and acknowledged.

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The use by the parties of identical and/or substantially similar marks in connection with identical goods would not leave us with any doubt that confusion would be likely, but even if this were a close case, we would have to resolve it in favor of opposer as the prior user and registrant, and against applicant, who, as the second comer, had a duty to select a mark that is unlikely to cause confusion with one that is already in use on the same or related goods or services. Squirrel Brand Co. v. Green Gables Investment Co., d.b.a. Green Gables Nut Farms, 223 USPQ 154 (TTAB 1984).

Decision: The opposition is sustained and registration to applicant is refused.